

### REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner has withdrawn the objections and rejections from the previous Official Action. However, the Examiner has rejected the claims under a new reference, U.S. Patent No. 5,836,867 to Speier et al. (hereinafter "Speier"). Specifically, the Examiner rejects claims 1, 3, and 4 under 35 U.S.C. § 102(b) as being anticipated by Speier. The Examiner also rejects claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Speier in view of U.S. Patent No. 5,577,991 to Akui et al. (hereinafter "Akui").

In response, independent claim 1 has been amended to clarify its distinguishing features.

The Examiner argues that Speier discloses moving the lens frame and adjusting the position of the optical elements relative to the imaging device. Speier discloses an endoscope having an optical element (1a), an imaging device (3) and an adjustment means. The adjustment is carried out by rotating an annular ring (6) which has magnets (10) magnetically coupled to similar magnets inside the housing (2). However, Speier neither teaches nor suggests a fixing member for fixing the optical elements which is provided at a predetermined position in a hermetic case. It should be noted that Akui also does not disclose any arrangement to fix optical elements in a hermetic case.

Independent claim 1 has been amended to recite the distinguishing features discussed above. Claims 2, 3, and 5 have been amended to be consistent with amended claim

1. Specifically, claim 1, as amended, now recites:

"a case for hermetically storing the optical elements and the imaging device;

a fixing member provided at a predetermined position in the case for fixing the optical elements; and  
an imaging device driving means for moving the imaging device to arbitrarily adjust the position of the imaging device relative to the fixed optical elements."

Such features are nowhere disclosed or suggested in Speier or Akui. The amendments to claim 1 are fully supported in the specification. Thus, no new matter has been entered into the disclosure by way of the present amendment to claim 1.

With regard to the rejection of claims 1, 3, and 4 under 35 U.S.C. § 102(b), an imaging unit for endoscopes having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Speier. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claim 1 is not anticipated by Speier. Accordingly, independent claim 1 patentably distinguishes over Speier and is allowable. Claims 3 and 4 being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 3, and 4 under 35 U.S.C. § 102(b).

With regard to claims 2 and 5, since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 2 and 5 are allowable therewith because they depend from an allowable base claim.

In other words, Independent claim 1, as amended, is not rendered obvious by the cited references because neither the Speier patent nor the Akui patent, whether taken alone

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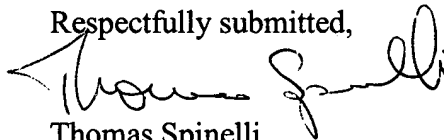
<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

or in combination, teach or suggest an imaging unit for endoscopes having the features discussed above. Accordingly, claim 1, as amended, patentably distinguishes over the prior art and is allowable. Claims 2 and 5, being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 2 and 5 under 35 U.S.C. § 103(a).

Lastly, the claims have been further amended to improve their form and readability. No new matter has been entered into the disclosure in doing so.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", written over a horizontal line.

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